

IP Section Licensing Committee Meeting

Friday, October 21, 2005 8:30 a.m. — 9:30 am

MINUTES

PARTICIPANTS: Paul Alpern (Co-Chair), Kevin DeBré (Co-Chair), Danielle Fern, Barbara Friedman (Ex Comm Liaison), Josh Hofheimer, Mickey Krieger, Allison Malin, Tom Malone, Gadi Navon, Stuart Pardau, Mike Plumleigh, Lee Rawles, Adam Samuels, Steve Sereboff, Steve Smyrski, Tom Speiss (Secretary), Greg Weisman and Jim Wright

I. Introductions

Mr. DeBré asked each participant to introduce him/herself and to briefly describe what they hoped to get out of joining the Committee. Most expressed a desire to share knowledge with other IP licensing lawyers.

II. Members Directory

Mr. DeBré said a new version of the Members Directory will be distributed next week. Committee members were requested to opt-in to be included in the Members Directory.

Mr. Navon asked whether the Directory will be distributed to members of the IP Section at large or just internally to Committee members. Mr. DeBré suggested that distribution of Directory can be discussed during the next Committee meeting, which will be held at the State Bar's Annual IP Institute. (The IP Institute will take place on Nov. 4-5 at the Napa Valley Marriott. The next Committee meeting will take place on Nov. 5 at 12:30 p.m., as part of the IP Institute. *See* Section IV, *infra*, for further details; *see also* www.calbar.org for registration information, the programs at a glance and a schedule of events.)

Mr. Krieger suggested enlarging the background section in the Directory. A suggestion was made to add a link to each member's bio posted on the website of their firm or company.

III. New Member Recruiting

Mr. DeBré said an article about the Licensing Committee will be published in the next issue of *New Matter*. In addition, a description of the Licensing Committee will soon be posted on the area devoted to the Committee on www.calbar.org website. (There

presently exist areas of the www.calbar.org website dedicated to the standing committees on Computer Law, Copyrights, Patents, Trademark and Trade Secrets.)

Mr. DeBré encouraged members to recruit colleagues and other lawyers they know who might be interested in joining the Committee.

IV. Agenda Topics for Committee Meeting Nov. 5 at IP Institute

Mr. DeBré said the Committee meeting will be 12:30 p.m. — 2:00 p.m. on Nov. 5. Mr. DeBré stated that we should discuss the purpose of the Committee. He suggested starting with a few, discrete projects and building upon incremental successes.

Mr. Alpern stated that each member of the Committee should reflect upon which licensing topics are of the greatest interest to them. He further stated that we should determine what “vehicle of communication” should members use to discuss Committee matters. He mentioned that some options include telephonic conferences, e-mail and videoconferencing.

In addition, there are five specific matters that the members felt should be discussed at the upcoming meeting:

- 1. Formation and utilization of an online discussion board/blog.** It was suggested that the Committee create an online message board for members, to, among other things: (1) list potential topics to discuss or present at upcoming meetings; (2) keep abreast of current issues; and (3) shape discussions offline.

Mr. Krieger stated that the INTA Trademark Forum (*see* www.inta.org) is a good model to follow. Mr. DeBré stated that he expected that an online message board up and running shortly — hopefully by the end of the year. In addition, it was suggested setting up a Yahoo or Google Group for now.
- 2. Social activities.** Mr. Hofheimer suggested planning an event for the first quarter of next year, perhaps drinks and a speaker for 10-15 minutes on recent developments relating to licensing. Mr. Krieger suggested possibly holding simultaneous events in Southern California and Northern California, connected by video conference.
- 3. Common agenda or structure.** Mr. Krieger suggested that a common agenda and common structure for Committee meetings would assist in creating direction for the Committee. Mr. DeBré stated the common agenda should be discussed and decided upon at the Nov. 5 meeting.
- 4. Seminar topics.** The following suggestions were made:

Mr. Hofheimer suggested that the Committee could hold a seminar on patent transactions and issues relating to private and public/university partnerships, including issues relating to the Bayh-Dole Act.

Mr. DeBré said that Barbara Friedman suggested putting on a seminar with another IP Section committee, such as the Copyright Committee or the Trademark Committee. He further stated that there may be topics in which the Licensing Committee and another section committee share an interest.

Mr. DeBré stated that Paul Livesay suggested having a seminar on the different perspectives of outside and in-house counsel in the IP licensing area.

V. Scheduling Future Meetings

Mr. DeBré asked how often and when Committee conference calls should be held. He suggested monthly for the time being and less frequently once the Committee's activities are established. Presently, conference calls are scheduled for the third Friday of each month (except November due to the IP Institute) at 8:30 am. Mr. Krieger said that this seemed fine for now and that scheduling and frequency will fall into place over time. No objections to this approach were voiced.

VI. Wrap-up

Mr. DeBré summarized the action items from the meeting:

1. Members were requested to send Mr. DeBré corrections and comments to their individual entries in the Members Directory, including a link to their online bio;
2. Ms. Friedman said that she would post the meeting minutes on the IP Section website; and
3. Mr. DeBré will distribute an agenda for Nov. 5 meeting.

Meeting adjourned.